

# Office Action Summary

Application No.

09/396,244

Applicant(s)

Examiner

cheukfan lee

Group Art Unit

2622

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9-15-99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-48 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 11-48 is/are allowed.
- ☒ Claim(s) 1 and 5-10 is/are rejected.
- ☒ Claim(s) 2-4 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 2622

1. Claims 1-48 are pending. Claims 1, 9-11, 17, 21-25, 34-37, and 45-48 are independent.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 and 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Stavely et al. (U.S. Patent No. 5,969,372).

Regarding claims 1, 8 and 9, Stavely et al. discloses an image scanning apparatus comprising all limitations claim. A light source (400 in Fig. 4C), which is a white light source, emits visible light and invisible light (infrared light IR) onto a film (col. 6, lines 52-64, exemplary embodiment shown in Fig. 4C). Fig. 4C is the figure relied upon in this rejection, the

Art Unit: 2622

characteristics of the white light source (400), including emission of both visible and infrared light, however, is explained in several sections other than the section for Fig. 4C (col. 6, lines 43-44, line 28, col. 5, lines 3-5, col. 8, lines 62-65). In each of several exemplary embodiments in which the film is scanned in reciprocal motion, the film is scanned twice (Scans A and B), once with IR light to provide an image of the surface defects such as dust or scratch) and once called normal scan with the direct white light to produce the image to be corrected using the data obtained from the IR scan (col. 4, lines 15-30, col. 2, lines 43-44, col. 5, lines 5-8). "The order of Scan A and Scan B is not import." This inherently means that the film is first scanned with IR and then scanned with direct white light for the image to be corrected using the data from the first scan.

Regarding claims 5 and 6, the scanning with IR is to detect abnormality such as dust or scratches on the film (col. 4, line 22, Abstract).

Regarding claim 7, the image data obtained in the normal scan is corrected by image processing means using the data obtained during the IR scan (col. 4, lines 15-25).

Regarding claim 10, the method of Stavely et al. is performed in a computer-controlled environment (col. 5, lines 6-13, for example).

4. Claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2622

5. Claims 11-48 are allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)  
(703) 308-5397 (for informal or draft communications, such as proposed  
amendments

to be discussed at an interview; please label such communications "PROPOSED"  
or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA  
Sixth Floor (Receptionist)

C. L.  
March 12, 2003

  
*Cheukfan Lee*